

REMARKS

Reconsideration and allowance of the subject application in view of the foregoing amendments and the following remarks is respectfully requested. Entry of this Amendment under Rule 116 is merited as it raises no new issues and requires no further search.

Claims 15-16, 21, 26, 37 are pending in the application. Claims 15-16, 37 have been rewritten in independent form including all limitations of the respective base claims and intervening claims. No new matter has been introduced through the foregoing amendments.

Constructively non-elected claim 47 has been canceled.

35 U.S.C. 112, second paragraph rejection of claims 6-17, 21, 22, 24, 26, 31

The *35 U.S.C. 112, second paragraph* rejection of claims 6-14, 22 and 24 and 31 is moot as these claims have been cancelled.

Applicants respectfully traverse the *35 U.S.C. 112, second paragraph* rejection of claims 15-16 and claims 21 and 26 depending from claims 16 and 15, respectively. The Examiner is questioning the degree of inflexibility being claimed. In response, Applicants respectfully direct the Examiner's attention to claims 15-16 and 24 where the degree of inflexibility of the substrate is specified either directly (claim 16) or indirectly through the hardness of the substrate (claim 15).

Withdrawal of the *35 U.S.C. 112, second paragraph* rejection of claims 15-16, 21, and 26 is believed appropriate and therefore courteously solicited.

Indication of allowable subject matter of claims 21 and 26 in the absence of art rejections is respectfully requested.

35 U.S.C. 102(b) rejection of claims 6-7, 9, 12 and 35-37 as being anticipated by Robbins

The 35 U.S.C. 102(b) rejection of claims 6-7, 9, 12, 35-36 is moot as these claims have been cancelled.

The 35 U.S.C. 102(b) rejection of claim 37 is traversed because the reference fails to teach or disclose each and every element of the rejected claims, especially the limitations of independent claim 35 (from which claim 37 depends) that (i) a substrate being made of a first material having a first hardness and (ii) a cut-resistant anti-slip coating on the working surface of said substrate, said coating being made of a second material having a second hardness greater than the first hardness.

In the Amendment filed February 19, 2003, the paragraph bridging pages 11-12, Applicants have argued that *Robbins* fails to anticipate independent claim 35. The Examiner nevertheless rejects claim 35 as being anticipated by *Robbins* without specifically responding to Applicants' arguments. Clarification is respectfully requested.

It is unclear from the language of paragraph 8 of the Final Office Action how *Robbins* teaches or discloses the above-highlighted limitations of independent claim 35, i.e., explicitly or implicitly.

Applicants have carefully reviewed the applied references and failed to locate any explicit teachings of the claim feature that the coating is made of a material harder than the substrate. Should the Examiner insists otherwise, Applicants respectfully request that more specific column and line numbers of *Robbins* be cited in support of the Examiner's position.

Robbins does not anticipate claim 35 by inherency. It is noted that the burden is on the Examiner to provide "a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis

added). *See* also *MPEP*, section 2112. As discussed in the paragraph bridging pages 11-12 of the February 19, 2003 Amendment, it necessarily follows from the teachings of *Robbins* that the *Robbins* mat has the opposite structure, i.e., with the substrate being made of a material harder than the coating.

For the above advanced reasons, Applicants respectfully request that the 35 U.S.C. 102(b) rejection of claim 37 be withdrawn.

**35 U.S.C. 102(b) rejection of claims 6-8, 10-14, 22, 35-39, 43-44, and 46 as being
anticipated by Harper (U.S. Patent No. 5,077,117)**

The 35 U.S.C. 102(b) rejection of claims 6-8, 10-14, 22, 35-36, 38-39, 43-44 and 46 is moot as these claims have been cancelled.

The 35 U.S.C. 102(b) rejection of claim 37 is traversed because the reference fails to teach or disclose each and every element of the rejected claim, i.e., said cutting lines **extend continuously** and **intersect** each other. Note, for example, Fig. 3 of *Happer* which discloses cut lines 32 that are all parallel and do not intersect each other.

35 U.S.C. 103(a) rejection of claim 40 as being obvious over Harper

This rejection is moot as claim 40 has been cancelled.

35 U.S.C. 103(a) rejection of claims 15-16, 41-42 and 45 as being obvious over Harper

The rejection of claims 41-42 and 45 is moot as these claims have been cancelled.

The 35 U.S.C. 103(a) rejection of claims 15-16 is traversed because *Happer* is not modifiable to include a base sheet 12 made of the rigid material of claims 15-16. Base sheet 12 of *Happer* must be flexible and conformable to an irregular pavement surface 16. *See* Abstract and

column 2, lines 3-5 and 58-59 of *Happer*. Using the hard material defined in claims 15 and 16 as the base sheet in the *Happer* pavement marking material would make the base sheet stiff, and render the *Happer* article being modified unsatisfactory for its intended purpose of providing improved adherence to irregular pavement surfaces. See also *MPEP*, section 2143.01 (If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)).

The Examiner's reliance on *In re Leshin* is therefore inapplicable in this case. A person of ordinary skill in the art would have been motivated to modify the *Happer* pavement marker only to an extent the marker remains satisfactory for its intended purpose. A person of ordinary skill in the art would not have been motivated to use the hard materials of claims 15-16 for the *Happer* base sheet.

35 U.S.C. 103(a) rejection of claims 6, 8, 24, and 35 as being obvious over van Schoyck in view of Robbins

This rejection is moot as the rejected claims have been cancelled.

Accordingly, all claims in the present application, namely, claims 15, 16, 21, 26, 37 are now in condition for allowance. Early and favorable indication of allowance is courteously solicited.

The Examiner is invited to telephone the undersigned, Applicant's attorney of record, to facilitate advancement of the present application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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